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PENNIE & EDMONDS, LLP
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

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In re Application of :
Weinrich et al. :
Application No. 08/785,559 :
Filed: 17 January, 1997 :
Attorney Docket No. 9276.2 :
ON PETITION

This is a decision on the "Petition for Correction of Filing Date under 37 C.F.R. § 1.10" filed on 16 June, 1999, which is being treated as a petition to withdraw the holding of abandonment for the above-identified application.

The Office apologizes for the delay in responding to the instant petition and regrets any inconvenience caused petitioner.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment" This is not a final agency decision.

This application became abandoned on 1 May, 1999 for failure to file a timely response to the non-final Office action mailed on 30 October, 1998, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. The filing of the instant petition precedes the mailing of Notice of Abandonment.

On 1 May, 1999, petitioner filed (a) a petition for a three (3) month time extension, (b) an amendment, (c) a revocation and power of attorney, (d) a substitute specification, (e) a redlined specification, and (f) a microfiche appendix. Petitioner asserts, however, that the above items were timely filed by "Express Mail Post Office to Addressee" on 30 April, 1999.

In support of the petition, petitioner has filed an affidavit by Josephine B. Hardy stating that she deposited the above-referenced items with "the appropriate USPS employee" in "Express Mail Post Office to Addressee" at 8:30 pm on 30 April, 1999, and was told by a USPS employee that the "Express Mail" mailing label would be mailed to the office of petitioner's counsel.

APPLICABLE LAW

37 CFR 1.10(a) states:

Any correspondence received by the Patent and Trademark Office that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. *If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.* (emphasis added)

37 CFR 1.10(d) states:

Where correspondence is deposited with the USPS and received by the Patent and Trademark Office and it is asserted that the "date-in" date on the "Express Mail Mailing" label was incorrectly entered or omitted, the person filing the correspondence may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS. A grantable petition under 37 CFR 1.10(d) requires:

(1) that the petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) the number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";

(3) the petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph **must**

be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

OPINION

The petition must be dismissed and the case abandoned because petitioner has not provided sufficient evidence to establish the "date-in" 37 CFR 1.10(a) requires a showing of the "date-in" on either the "Express Mail" mailing label or other official documentation from the USPS. As the standard practice of the USPS is to provide a copy of the "Express Mail" mailing label showing the "date-in" at the time of deposit, this situation is highly unusual. Petitioner should have requested a copy of the "Express Mail" mailing label at the time of deposit. Furthermore, petitioner has not shown that any further attempts have made to obtain the "Express Mail" mailing label from the USPS despite the fact that over one and one-half months have elapsed between the alleged mailing of the above-referenced correspondence and the filing of the instant petition. As such, petitioners have demonstrated a lack of diligence.

Additionally, there is no indication in the petition that any of the evidence proffered came into being after deposit and within one business day of the deposit of the correspondence as required by 37 CFR 1.10(d). The late hour of deposit, combined with the failure of the individual depositing the correspondence to obtain at the time of deposit with the USPS the "Express Mail" mailing label showing the "date-in" leads to the conclusion that the correspondence was deposited subsequent to the last scheduled pickup for that day. Any renewed petition must include a showing that the correspondence was actually deposited prior to the last scheduled "Express Mail" pickup for the day of deposit.

It is additionally noted that the postcard receipt submitted with the instant petition as evidence that the correspondence described above was timely filed does not support petitioner's contention because it was stamped by the Patent and Trademark Office as received on 1 May, 1999. Furthermore, although the words "MAIL DATE CANCELED" were stamped across the date stamp of 1 May, 1999, the words "MAIL DATE CANCELED" are in red while the copy is in black and white, leading to the conclusion that the words "MAIL DATE CANCELED" were not stamped on the postcard receipt received from the PTO but were added separately to this copy. Additionally, although the petition and affidavit are dated 17 June, 1999, they have been stamped as received on 16 June, 1999, by the Patent and Trademark Office.

As petitioner has not provided sufficient evidence of timely filing of the request for a three month time extension and amendment, the petition is dismissed and the case is abandoned. The Notice of Allowance and Issue Fee Due and Notice of Allowability, both mailed on 2 August, 1999, are VACATED.

Accordingly, this application remains abandoned.

ALTERNATE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and
- (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

REFUND OF EXTENSION OF TIME FEE

Petitioner submitted \$435.00 for a three month extension of the time to reply to

the Office action mailed on 30 October, 1998. An extension of time under 37 CFR 1.136(a) must be filed prior to the expiration of the maximum extendable period for reply.¹ Accordingly, since the one month extension of time submitted with the petition on 20 January, 1999, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's deposit account.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
 Box DAC
 Washington, D.C. 20231

By FAX: (703)308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
 2201 South Clark Place
 Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood, at (703)308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Enclosure: Form PTO/SB/64

¹See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).